

**REMARKS**

Applicants thank the examiner for acknowledging the claim to priority under 35 U.S.C. § 119. Applicants note, however, that the Examiner has not acknowledged receipt of the certified copy of the priority document filed July 12, 2004. Applicants respectfully request that, in the next Office action, the Examiner acknowledge receipt of the previously filed priority document.

Applicants also thank examiner for considering the references cited with the Information Disclosure Statement filed August 11, 2004.

**Status of the application**

Claims 1-11, 14 and 15 have been examined and rejected.

**Claim Rejections**

**I. Rejections under 35 U.S.C. § 112, second paragraph**

Claims 7 and 9 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for lack of antecedent basis. Applicant respectfully submits that the claim rejections under 35 U.S.C. § 112, second paragraph, in the Office action are ambiguous.

Specifically, claim 7 is referenced in paragraph 2 of the Office action, but no further comments pertaining to claim 7 are found in the 35 U.S.C. § 112 rejection section of the Office action. Applicants suppose that paragraph 3 of the Office action was meant to refer to claim 7.

Further, in paragraph 4 of the Office action the Examiner bases the 35 U.S.C. § 112 rejection of claim 9 on the “the limitation ‘the averaging sequence’ in line 2 of the claim.”

Claim 9, however, does not contain that limitation. Rather, the limitation appears in line 2 of claim 8.

Therefore, Applicants have proceeded on the basis that the Examiner applied a 35 U.S.C. § 112 rejection against claim 7 according to the comments in paragraph 3 of the Office action, and against claim 8 according to the comments in paragraph 4 of the Office action.

Accordingly, claims 7 and 8 have been amended. Applicants respectfully request that the 35 U.S.C. § 112 rejections of claims 7 and 8 be withdrawn.

## **II. Rejections under 35 U.S.C. § 102(b)**

Claims 1, 2, 9, 10, 11, 14, and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Otting et al. (USPN 6,477,372 B1) (“Otting”). Applicants respectfully traverse these rejections on the following basis.

Exemplary embodiments of the current invention provide a novel and unobvious method of *acquiring* a cellular communications network. For example, claim 1 recites a method whereby the time necessary to complete a technology scan and acquire a communications network is reduced by taking a series of measurements of a received signal characteristic in a particular technology. Before completing the series of measurements, the method compares the measured characteristic to a predetermined value. If the comparison indicates a low likelihood of finding an acceptable cell in the measured technology, the method switches technologies and begins a new series of measurements. The time required for technology scan and network

acquisition is reduced because the method makes the determination to switch technologies before the full series of measurements is complete. Otting does not teach this feature.

Otting discloses a method for *allowing* a radiotelephone to scan for alternate radiotelephone systems while the radiotelephone has service on a network (col. 5, ll. 7-9). The method of Otting allows a radiotelephone to perform an alternate technology scan while remaining camped on its current network (col. 4, ll. 17-59, and col. 5, l. 50 - col. 6, l. 46). The request to allow the scan may be made from the radiotelephone, but the scan is not initiated until permission is received from the base station (Id.). By granting permission to scan, the current network base station agrees to keep the radiotelephone on its active list during the alternate technology scan, thereby eliminating the need for the radiotelephone to reestablish a connection with the base station (Id.). Otting therefore teaches a method for initiating an alternate technology scan but not a method for performing the scan.

Since Otting does not teach or suggest at least a method whereby the time necessary to complete a technology scan and acquire a communications network is reduced, applicants respectfully submit that Otting does not teach or suggest each and every element of claim 1. Also, applicants submit that Otting does not teach or suggest every element of claims 10, 11 and 14-15 for similar reasons. Therefore, applicants respectfully request the 35 U.S.C. 102(b) rejection of claims 1, 10, 11 and 14-15.

Further, since independent claims 1 is patentable over Otting, dependent claims 2 and 9 are also patentable at least by virtue of their dependency on claim 1. In addition, dependent

claims 2 and 9 are separately patentable over the prior art by reason of the additional limitations set forth therein. Accordingly, applicants respectfully request that the 35 U.S.C. § 102(b) rejections of claims 2 and 9 be withdrawn.

**III. Rejections under 35 U.S.C. § 103(a)**

Claims 3 and 8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Otting in view of Nakano (USPN 6,725,041) (“Nakano”).

As noted above, Otting teaches a method for initiating an alternate technology scan but not a method for performing the scan. The method of Otting does not involve the process of determining a suitable cell, but rather the process of initiating that determination. Nakano teaches a method of determining a handover destination base station within a radio technology by extracting and averaging signal strengths of cells within range of the mobile unit (col. 3, ll. 57 - col. 4, ll. 12). Conversely, exemplary embodiments of the current invention provide a method for rapidly determining if a suitable cell exists within a current radio technology and if not, switching to a different technology to search for a suitable cell.

Neither Otting nor Nakano teach switching to an alternate technology based on the results of signal averaging. Further, because Nakano is applicable to processing decisions during a scan while Otting is applicable to the unrelated process of determining if a scan can be initiated, it would not have been obvious to one of ordinary skill in the art to combine the teachings. Since the teachings address unrelated problems, the references themselves provide no motivation to combine.

Therefore, since no motivation exists to combine the references, and since the references do not teach every limitation of claims 3 and 8, applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 3 and 8 be withdrawn.

Claims 4 and 5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Otting in view of Dillinger (US 2004/0058679 A1) (“Dillinger”). Otting teaches a method for initiating an alternate technology scan but not a method for performing the scan. For example, Otting does not teach or suggest at least a method whereby a suitable cell is chosen based on measurement of a signal characteristic prior to a final measurement as in exemplary embodiments of the current invention. Dillinger also does not teach this feature.

Dillinger discloses a method whereby the mobile unit tests all available cells satisfying a threshold criteria in all available network technologies and stores a resulting list in the mobile unit’s memory (para. 51-54). Dillinger does not teach or suggest at least reducing the time required to choose a new cell by determining if an appropriate cell exists prior to a making a final measurement. Therefore, since the references do not teach every limitation of claims 4 and 5, applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 4 and 5 be withdrawn.

Claims 6 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Otting in view of Brody (USPN 4,670,899) (“Brody”). The method of Otting does not involve the process of determining a suitable cell on a cellular communications network. Otting teaches a method for determining if that process will be initiated. Brody discloses the use of a received

signal strength indicator (RSSI) to produce an ordered list of possible cells for call hand-off within a cellular network (col. 18, ll. 1-12). However, since Otting does not teach or suggest a method of choosing a suitable cell among available alternate cellular network technologies and Brody fails to cure this deficiency, the combined references do not teach or suggest all the claim limitations of claims 7 and 8. For example, they fail to teach at least switching to an alternate technology.

Accordingly, since the references do not teach every limitation of claims 7 and 8, applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 7 and 8 be withdrawn.

**IV. Claim Objections under 37 C.F.R. § 175**

Claims 14 and 15 have been objected to as allegedly being substantial duplicates of claims 1 and 10. Claims 14 and 15 have been amended.

**V. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111 Docket No. Q78522  
U.S. Appln. No. 10/714,847

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

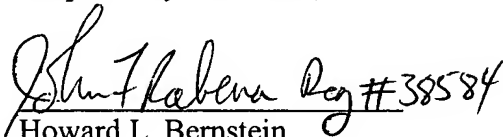
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

*for*  Reg #38584  
Howard L. Bernstein  
Registration No. 25,665

Date: November 23, 2005